



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/502,280

05/11/2005

Andreas Myka

617-011873-us

3300

2512

7590

03/05/2008

PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

EXAMINER

LIN, WEN TAI

ART UNIT

PAPER NUMBER

2154

MAIL DATE

DELIVERY MODE

03/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/502,280	Applicant(s) MYKA ET AL.	
	Examiner Wen-Tai Lin	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-21 and 24 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 22 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24 are presented for examination.
2. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.
3. The claim(s) contain(s) subject matter that is optionally recited. See the "whereby" clause in claim 1. As such, the claims bear no patentable weight. See MPEP § 2106 Section II(C): The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.
4. Claims 1-12 are objected to because the term “adapted to” do not refer to any specific functional or structural supports and therefore does not constitute any patentable sense. For purpose of prior art rejection, these terms/words are being construed as “providing means for”.

Claim Rejections - 35 USC § 103

5. Claims 1-9, 12-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durrett [U.S. Pat. No. 5964830] in view of Official Notice.

6. As to claim 1, Durrett teaches the invention substantially as claimed including:

a system for providing personalized services for mobile users, the system comprising: a plurality of mobile terminals, each mobile terminal being provided with means for acquiring personal content, said personal content including at least one of photographs, text, video, speech, calendar information, and location information [e.g., encryption keys (e.g., 13A, Fig.5A), user ID and password – see col. 2, lines 40-49; col. 7 line 54 – col. 8 line 3];

storage means in the mobile terminal, the storage means being adapted to store at least a first part of the personal content acquired [e.g., col.2, lines 40-49; note that in several embodiments Durrett teaches using touch memory to hold up authentication information (col.3, lines 40-58), and in one embodiment, Durrett even teaches that the portal may even install non-volatile memory such as local disk (see col.2, lines 20-24; col.3, lines 4-14)];

at least one remote data repository connected to the telecommunications system for storing at least a second part of the personal content acquired by the plurality of mobile terminals, whereby at least one of the repositories is assigned for the use of each mobile terminal [i.e., for authentication purpose a set of user ID and password must have been stored at the access provider];

means adapted to transfer a selected part of the personal content between the storage means and the at least one remote data repository through said telecommunications system, the means including predetermined criteria the fulfillment of which initiates said transfer [e.g., 81-82

and 88, Fig.6C ; i.e., transfer of the entered user ID and password follows a nominal authentication procedure];

means for extracting data from said at least a first part of the personal content, association means for associating said extracted data with said at least a second part of the personal content [i.e., the newly entered user ID and password, which forms as a first part of the personal content, are compared with the user ID and password, forming as a second part of the personal content, that are stored in the repository]; and

service provision means responsive to said association means, the service provision means being adapted to generate and/or provide a personalized service incorporating at least one of said photographs, text, video, speech, calendar information, and location information and using said extracted data associated with said at least a second part of the personal content [e.g., col.2, lines 40-49; col.5 lines 45-51].

Durrett does not specifically teach that the portable device uses wireless communication with a telecommunications system.

However, Official Notice is taken that portable device equipped with wireless communication capability is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to also provide the portable device with such capability because wireless communication would enhance the device's portability/mobility and Durrett does not preclude the use of more sophisticated portal devices [col.3, lines 4-14].

7. As to claim 2, Durrett teaches that the system further comprising:

selection means for selecting data to be retrieved from an external data storage, the selection being made at least partially on the basis of said extracted data;

means for receiving said selected data;

and association means adapted to associate said received data with the personal content stored in the data repository, wherein the service provision means are adapted to utilize said received data for generating and/or providing said personal service [col.2 lines 40-54].

8. As to claim 3, Durrett teaches that the system further comprising:

communication means adapted to retrieve at least one stored object and/or item of data extracted from the remote data repository;

and a server including application software adapted to perform an action as a result of which information is generated, the action to utilize the retrieved object and/or said data extracted [col.2 lines 50-54; Figs. 6A-6C].

9. As to claim 4, Durrett teaches that the system further comprising means for storing said extracted information in said remote data repository [i.e., in the process of establishing User ID or password and pre-stored it with the remote server, both User ID and password are originally derived from the user entered data that are temporarily stored in local RAM or registers].

10. As to claim 5, Durrett does not specifically teach that the system further comprising means for generating charging information on the basis of the action performed.

However, Official Notice is taken that charging-by-hours is one of the popular billing method for ISP providers. Although Durrett does not teach how its virtual disk subscribers are

charged. It is an obvious option to one of the ordinary skill in the art to implement such a billing method. That is, by generating charging information on the basis of the action performed because it offers incentive to infrequent users to take this billing option.

11. As to claims 6-7, Durrett teaches that the system further comprising:

means responsive to said processing adapted to allow access of the application software to an object and/or stored information in the remote data repository; and means responsive to said processing adapted to send an object and/or extracted information in the remote data repository to the server in order to enable provision of the service requested [Abstract; col. 1, lines 40-65; col.5, lines 45-51].

Durrett is silent about means to subscribe to a service by sending a request to a server and means to process said request on said server.

However, sending a request to subscribe a service and processing the request on a server is a typical subscription procedure in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement such as subscription step because this is a typical way of building a subscription relationship (e.g., by establishing an access key for the subscriber) between the subscriber and the service provider [col.2, lines 50- 59].

12. As to claim 8, Durrett further teaches that the service requested is identified in the request [col.2, lines 44-49].

13. As to claim 9, Durrett further teaches that an object and/or extracted information is identified in the request, the object and/or extracted information defining the action to be performed by the server [Abstract; note that in the download service, a user needs to identify the requested object to be downloaded via the server].

14. As to claim 12, Durrett further teaches that said means for extracting data from said personal content include at least means to perform i) optical character/text recognition or ii) pattern recognition [note that the key matching process is a pattern recognition process based on the scanned fingerprint [col.5 lines 45-51 and col. 2, lines 50-54].

15. As to claims 13-21 and 24, since the features of these claims can also be found in claims 1-9 and 12, they are rejected for the same reasons set forth in the rejection of claims 1-9 and 12 above.

16. Claims 10-11 and 22-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Applicant's arguments filed on 11/20/2007 for claims 1-24 have been fully considered but they are not deemed to be persuasive.

18. Applicant continues to argue in the remarks that the Durrett reference together with examiner's reliance on inherency and official notice, and that Durrett's portal device is a dumb

terminal; he does not suggest use of local memory to hold authentication information such as fingerprints.

First, Applicant is reminded that for each occurrence where the Official Notice is taken, Applicant could have formally request evidentiary support. Likewise, argument toward inherency or obviousness could have been made by specifically pointing out why each use of inherency or obviousness is inappropriate (see MPEP 2144.03C).

Second, to avert Applicant's assertion that Durrett only suggests the use of a dumb terminal and nowhere does Durrett teach using local memory to hold authentication information such as fingerprints: Applicant is directed to col.3, lines 4-14, wherein Durrett teaches that the portal may even install non-volatile memory such as local disk. Furthermore, in almost all embodiments Durrett teaches using touch memory to hold up authentication information such as fingerprint or password [e.g., col.3 line 40 – col.4 line 35].

For at least the above reasons, it is submitted that an ordinary skill in the art could have come up with the claimed invention based on Durrett's teachings and other obvious advantages such as adding wireless communication capability and defining appropriate billing procedure to charge the subscription of virtual disk in Durrett's system.

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially

teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(571) 273-8300 for official communications; and

(571) 273-3969 for status inquiries draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

February 26, 2008

/Wen-Tai Lin/

Primary Examiner, Art Unit 2154

